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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/169,351	10/09/98	CORBITT	J P/3120-9

002352 QM32/0719
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NEW YORK NY 10036-8403

EXAMINER

JACKSON, S

ART UNIT	PAPER NUMBER
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3738

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DATE MAILED: 07/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/169,351

Applicant(s)
Corbitt, Jr. et al.

Examiner
Suzette Jackson

Group Art Unit
3738



☒ Responsive to communication(s) filed on Apr 19, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-24 is/are pending in the application.

Of the above, claim(s) 4 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3, 5-11, and 14-24 is/are rejected.

☒ Claim(s) 12 and 13 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Applicant's amendment dated 19 April 2000 has been received in application serial number 09/169,351. Claim 4 has been canceled.
2. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 U.S.C. § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5-6, 10, 16- 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Naficy 4,298,998 which discloses the invention as claimed comprising:an outer shell of resorbable material and an inner fluid core, the implant being formed to fit the shape and size of a cavity in the human body, the implant configured to be installed for supporting tissue surrounding the cavity and allowing in-growth of fibrous tissue into and replacing the outer shell (see figures 5-13 and column 3, lines 5-10, 14-21).

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Claim Rejections - 35 U.S.C. § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-9, 11, 14, 15, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naficy in view of Wallace et al. 6.066.325. Naficy has been disclosed above, however the fluid core of Naficy does not state specific medical substances. Wallace discloses cross-linked hydrogel for filling voids or divots in tissue tracts and body cavities and delivery of drugs and other active agents, such as biological macromolecule, polypeptides, oligopeptides, nucleic acids, small molecule drugs and the like, thrombin, fibrinogen clotting factor depending upon the patients needs (see col. 4, lines 1-21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate medicinal drugs taught by Wallace into the fluid core of Naficy because it would further serve to fight infection and provide acceptance of the implant. Wallace further teaches that the hydrogel has the ability to be extruded through a syringe thus being able to conform to holes, pockets, divots (see col 4, lines 42-61) which give it a self-expanding capability. It would have been obvious to one having ordinary skill in the art to utilize the hydrogel of Wallace and the resorbable shell of Naficy in order to allow for a specific shape to a cavity void.

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Allowable Subject Matter

7. Claims 12 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 19 April 2000 have been fully considered but they are not persuasive. Applicant contends that there is no fluid core in Liu et al. The new rejection above addresses and discloses the amended claims.

Conclusion

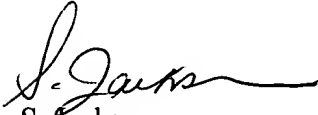
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communication regarding this application should be directed to examiner Suzette Jackson at (703) 308-6516. If you are unable to reach me, please contact my supervisor, Vincent Millin, at (703) 308-1065. In a case requiring immediate assistance, please call (703) 308-0858 to reach the main operator for Sector 3700.


S. Jackson
13 July 2000


David H. Willse
Primary Examiner